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February 14, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
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Re: **Application Serial No.:** 09/398,182
Confirmation No.: 9748
Previous Appeal No.: 2003-0098
Appellants: Alan J. Rozlosnik, et al.
Title: Receipt Delivery System for Secure Depository
Docket No.: D-1118 R2

Sir:

Please find enclosed an Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application. As this application has been pending for over five (5) years, an advancement of decision is respectfully requested.

Please charge any necessary fee for filing this Second Appeal Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31, 029

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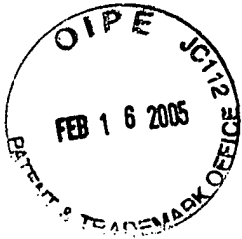
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D-1118R2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: 2003-0098)	
)	
In re Application of)	
Alan J. Rozlosnik, et al.)	
)	Art Unit 2876
Application No.: 09/398,182)	
)	
Confirmation. No.: 9748)	Patent Examiner
)	April A. Taylor
Filed: September 17, 1999)	
)	
Title: Receipt Delivery System)	
for Secure Depository)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their 2nd Appeal Brief concerning the above-referenced Application. This 2nd Appeal Brief is in response to the Office Action dated September 17, 2004, which reopened prosecution following a decision by the Board of Patent Appeals and Interferences (hereinafter "Board"). Appellants respectfully request reinstatement of their appeal.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

In this application a Board decision regarding Appeal No. 2003-0098 was previously rendered on June 22, 2004. In said decision the Examiner was reversed on all issues.

This application and application 10/280,238 both claim priority to provisional application 60/114,036. Application 10/280,238 has also been appealed. However, it is respectfully requested that the Board make its own determination regarding the pertinence of application 10/280,238. Appellants, Appellants' legal representative, and assignee believe that there are no other related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-18 are pending in the Application.

Claims rejected: 1-18

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-18, inclusive. These rejections were the only rejections present in the Office Action ("Action") dated September 17, 2004.

(iv)

STATUS OF AMENDMENTS

The non-final Action dated September 17, 2004 reopened prosecution following a Board decision in Appeal No. 2003-0098. The Board decision completely reversed the Examiner. As shown in more detail herein, Appellants' claims are also allowable over the new grounds of rejection. Thus, Appellants respectfully request reinstatement of their appeal.

No final rejection has been made. However, claims have been rejected at least twice. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to a method. The method includes conducting at least one transaction at a deposit accepting machine (10; Figure 1; page 10, lines 2-4). The method further includes printing a receipt (109) including indicia corresponding to the transaction with a printer (122) in an interior area of the machine (10). The method additionally includes extending a receipt (109) intermediate of an exterior wall (121) of the machine and an overlying member (30), wherein the overlying member (30) includes an aperture (125) therein sized for accepting a finger of a user (Figures 38 and 39). The method also includes moving the receipt (109) in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall (121) and the overlying member (30) (page 17, lines 4-19).

With respect to independent claim 16

Another exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The method includes extending a printed receipt (109) intermediate of an exterior wall (121) of a deposit accepting machine (10) and an overlying member (30), where the overlying member (30) includes an aperture (125) therein sized for accepting a finger of a user (page 17, line 1) (Figures 38 and 39). The method further includes moving the receipt (109) in sandwiched relation between a finger

extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member (page 17, lines 4-19).

With respect to independent claim 18

Another exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The method includes extending a printed receipt (109) intermediate of an exterior wall (121) of a deposit accepting machine (10) and an overlying member (30), where the overlying member includes an aperture (125) therein sized for accepting a finger of a user (page 17, line 1). The exterior wall (121) includes an opening (113). The overlying member (30) extends from generally above the opening (113) to a generally downward facing edge (119) positioned below the opening (113). The aperture (125) extends below the opening (113).

The method further includes moving (page 17, lines 4-19; Figures 38 and 39) the receipt (109) in sandwiched relation between a finger extended in the aperture (125) and the exterior wall (121) to remove the receipt (109) from between the exterior wall (121) and the overlying member (30), with the receipt (109) moved generally downward by movement of the finger in the aperture (125). The overlying member (30) being disposed in proximity to the exterior wall (121) such that a receipt (109) extending therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt (109) by engagement with a finger through the aperture (125). The method additionally includes subsequent to moving the receipt (109) by movement of the finger in the aperture (125), manually grasping the receipt (109).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 1-9 and 14-18 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Bohnert, et al. (US 5,797,470) (hereinafter "Bohnert").
- 2). Whether claims 10-13 are unpatentable pursuant to 35 U.S.C. § 103(a) over Bohnert in view of Caldwell (US 4,754,126).

(vii)

ARGUMENT

The 35 U.S.C. § 102(e) Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Bohnert does not anticipate the claims

Claims 1-9 and 14-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bohnert. The Action relies upon Bohnert at Figure 7 and col. 3, line 62 to col. 6, line 52. The Action alleges that Bohnert teaches an overlying member (54). This is the only recited feature that the Action has referenced by numeral. Bohnert's many elements are clearly numbered. However, the Action is silent with regard to indicating that any recited features of Appellants' claims are shown in Bohnert.

Claim 1

Bohnert is non analogous art. Bohnert is directed to a fuel dispensing (14). Bohnert relates to accepting fuel *payments*, whereas claim 1 relates to accepting *deposits*. Even the Action (on page 5) admits that Bohnert does not teach "depositing an article". The Office has not properly considered Appellants' disclosure in determining the meaning of terms used in the claim. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995). Nor has the Office granted a heavy presumption that the claim terms have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. *Texas Digital Sys, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002). One skilled in the art of banking (and a conventional bank customer) would understand the meaning of a "deposit" (Specification page 1, lines 2-4).

Appellants question the allegation that Bohnert teaches a deposit accepting *machine*. The Action is conveniently silent as to which of Bohnert's numbered elements allegedly constitutes the recited "machine". Nevertheless, Bohnert does not teach a machine in the manner recited. In Bohnert the terminals (17, 18) are free-standing and are situated *independently* from the fuel

dispensers (14, 20) (col. 4, lines 17-19). The terminals (17, 18) and fuel dispensers (14, 20) do not communicate with each other, but rather with a remote central master terminal (19) (Figure 2). A terminal (17, 18) is not part of a fuel dispenser (14, 20). However, Bohnert requires both a terminal (17, 18) and a fuel dispenser (14, 20) to conduct a fuel dispensing transaction. That is, Bohnert requires a user to operate distinct *machines* to carry out a single transaction. Conversely, claim 1 recites that it is the same machine where the transaction is conducted and where the receipt (corresponding to the transaction) is printed.

Bohnert also does not teach the alleged overlying member (54) having an aperture therein sized for accepting a finger of a user. Bohnert actually teaches that the element (54) is a receipt printer. Where does Bohnert teach that the receipt printer (54) has an aperture "sized for accepting a finger of a user"? Bohnert is silent on the issue. It follows that any interpretation by the Office is purely speculative. However, an anticipation rejection cannot legally be based upon speculation. *In re Robertson*, supra.

Even if Bohnert explicitly taught an aperture, there would still be no teaching of using the aperture to manually move a receipt. For example, what would prevent the aperture from being only used to prevent receipt curl? What would prevent the aperture from being used merely for cosmetic appearance? Also, the use of apertures is a known manufacturing technique for using less material to achieve the same structural ability with less costs. Thus, any function attributed to using an aperture (without an explicit teaching) is pure speculation.

Nor does Bohnert teach moving a receipt in the manner recited. Bohnert does not teach moving a receipt in sandwiched relation between a finger (extended in an aperture of an overlying member) and an exterior wall of a deposit accepting machine to remove the receipt.

Bohnert is silent as to exactly how a user retrieves a receipt. Where does Bohnert even teach having a receipt sandwiched between a finger and a wall? Any interpretation by the Office is again purely speculative. Again, an anticipation rejection cannot legally be based upon speculation. *In re Robertson*, supra.

For sake of argument, even if Bohnert taught (which he doesn't) the receipt printer (54) with an aperture sized for accepting a finger of a user, there still wouldn't be any teaching in Bohnert of how the receipt is moved. Nor does Bohnert inherently limit a user to only moving a receipt in the manner recited (step d). For example, where does Bohnert teach that a user is prevented from inserting a finger behind a receipt in order to move the receipt? That is, in Bohnert what limitation prevents a receipt from being sandwiched between a first finger and (instead of an exterior wall) a second finger (e.g., thumb)? Therefore, (even if Bohnert had an aperture sized for accepting a finger) Bohnert still would lack a teaching of moving a receipt in sandwiched relation between a (single) finger and an exterior wall. The recited method is not "necessarily present" in Bohnert. *In re Robertson*, supra. It follows that Bohnert does not explicitly or inherently teach the recited method.

Furthermore, Bohnert structurally teaches against the recited invention. In Bohnert the receipt printer (54) has an angled member (Figure 7) extending outwardly therefrom. Because of the angle a significant increasing gap exists between the angled member and the adjacent wall (located behind the angled member). Again for sake of argument, even if Bohnert were to teach the angled member having an aperture sized for accepting a finger, the gap is structurally too large to enable the moving of a receipt against the wall with a finger, especially while the finger remains "in the aperture". Contrary to Bohnert's teaching, in an exemplary arrangement (Figure

38) of Appellants' invention the exterior wall (121) and overlying member (30) are substantially parallel. In Bohnert, a finger in an aperture (for sake of argument) would be awkwardly angled away from (not toward) the receipt. Bohnert's use of an angled member further points to (at best) his receipt being sandwiched between fingers, not between a (single) finger and an exterior wall. Furthermore, with Bohnert's large gap a receipt may be manually grasped without the need to even extend a finger in the aperture. Why would a user need to inconveniently extend a finger in an aperture in the alleged overlying member (54) when they can easily extend their finger(s) under the alleged overlying member (54) to grasp the receipt? It follows that Bohnert does not explicitly or inherently teach the recited method. Bohnert does not anticipate claim 1.

The Office's allegation of anticipation is based on unsupported speculation. The record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Claim 2

Bohnert further does not explicitly or inherently teach moving a receipt in the manner recited. Bohnert does not teach moving a receipt in sandwiched engagement between a finger and an exterior wall. Bohnert does not anticipate claim 2.

Claim 3

Claim 3 depends from claim 2. Evidence has not been presented that Bohnert moves a receipt in generally a downward direction in the manner recited. Bohnert does not anticipate claim 3.

Claim 4

Claim 4 is directed to cutting supply roll paper with a cutter. Where does Bohnert explicitly or inherently teach using a paper roll? The relied upon section of Bohnert at col. 6, lines 30-38 doesn't even mention a paper roll. What structure prevents Bohnert from using perforated flat paper sheets for receipts? Again, the Office's allegation of anticipation is based on pure speculation. Bohnert does not anticipate claim 4.

Claim 5

Claim 5 depends from claim 4. Bohnert further does not explicitly or inherently teach the recited relationship between receipt positioning and cutting. Where does Bohnert teach executing cutting *when* the receipt is positioned extending below an aperture but not substantially below an edge? The relied upon section of Bohnert at col. 6, lines 30-38 doesn't teach the recited relationship. Bohnert does not anticipate claim 5.

Claim 6

Claim 6 depends from claim 1. Bohnert further does not teach the relationships of the overlying member, aperture, exterior wall, and opening. Bohnert does not teach an exterior wall including an opening, where the alleged overlying member (54) extends from generally above the opening to an edge positioned below the opening. Nor does Bohnert teach an aperture (in the alleged overlying member) extending below the opening. Nor does Bohnert teach moving a receipt downward by movement of a finger in the alleged aperture. As Bohnert is silent as to the structural arrangement of the alleged overlying member (54) relative to other components, the Office's allegation of anticipation is based on unsupported speculation.

For sake of argument, even if Bohnert had an aperture and an opening (which he doesn't) what would prevent the aperture from extending above (or equal with) the opening? That is, what prevents Bohnert from having structure differing from that recited in the claim? It follows that the recited method is not "necessarily present" in Bohnert. *In re Robertson*, supra. Bohnert does not anticipate claim 6.

Claim 7

Claim 7 depends from claim 1. Bohnert further does not teach the recited overlying member and exterior wall proximity relationship. Bohnert does not teach that the alleged overlying member (54) is disposed in proximity to an exterior wall so that a receipt extending therebetween *cannot* be manually grasped with fingers prior to moving the receipt by engagement with a (single) finger through an aperture (in the overlying member). Conversely, as previously discussed (e.g., claim 1 remarks), Bohnert's large gap (due to the angled member) permits a receipt to be manually grasped with fingers prior to moving the receipt.

Nor does Bohnert teach manually grasping the receipt after moving the receipt with a finger. Bohnert does not teach moving a receipt in the order recited.

Bohnert does not explicitly or inherently teach the recited method. Again, the Office's allegation of anticipation is based on pure speculation. Bohnert does not anticipate claim 7.

Claim 8

Claim 8 depends from claim 6. Bohnert further does not teach the relationship between an aperture and a receipt and a thumb in the manner recited. Where does Bohnert teach an aperture in the alleged overlying member (54) that is centered relative to a receipt? Where does Bohnert teach an aperture in the alleged overlying member (54) that is sized for accepting a

thumb therein? Nor does Bohnert teach moving a receipt downward by movement of a thumb. Bohnert does not anticipate claim 8.

Claim 9

Claim 9 is directed to cutting a receipt with a cutter. Bohnert further does not teach that movement of a receipt in sandwiched relation between a finger extended in an aperture and an exterior wall is operative to cut the receipt in the manner recited. Bohnert does not anticipate claim 9.

Claim 14

Bohnert further does not teach fitting a panel on an exterior surface of an *existing* deposit accepting machine, where the printer is housed in the panel. In an exemplary embodiment (page 20, lines 12-15; Figure 38) of the invention, a control panel (16) is retrofit to an existing depository. Bohnert teaches neither a panel nor retrofitting. Bohnert does not anticipate claim 14.

Claim 15

Claim 15 depends from claim 14. Bohnert further does not teach receipt indicia including an inputted value in the manner recited. Bohnert has a conventional gasoline station receipt (col. 5, lines 64-65). Where does Bohnert teach inputting a value through an input device, and printing a receipt having indicia including the input value? The relied upon sections of Bohnert at col. 3, line 62 to col. 6, line 52 and col. 10, line 47 to col. 11, line 23 don't teach the recited method. Bohnert does not anticipate claim 15.

Claim 16

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. Bohnert does not teach the recited method. For example, for reasons previously discussed, Bohnert does not teach moving a receipt in the manner recited. Bohnert does not anticipate claim 16.

Claim 17

Claim 17 depends from claim 16. Bohnert further does not teach the relationships of an overlying member, a generally downward facing edge, an exterior wall, an opening, and receipt in the manner recited. Bohnert does not anticipate claim 17.

Claim 18

Claim 18 includes a combination of subject matter from claims 1, 3, 6, 7, and 16. Appellants' remarks in support of the patentability of these claims are incorporated herein by reference. As previously discussed, Bohnert does not teach the steps, features, and relationships that are specifically recited in any of claims 1, 3, 6, 7, and 16. It follows Bohnert cannot teach the combination of steps, features, and relationships that are specifically recited in claim 18.

For example, for reasons previously discussed, Bohnert does not teach an exterior wall including an opening, where the alleged overlying member (54) extends from generally above the opening to a generally downward facing edge positioned below the opening. Nor does Bohnert teach an aperture (in the alleged overlying member) extending below the opening. As Bohnert is silent as to the structural arrangement of the alleged overlying member (54) relative to other components, the Office's allegation of anticipation is based on unsupported speculation.

For sake of argument, even if Bohnert had (which he doesn't) an aperture and an opening, what would prevent the aperture from extending above (or equal with) the opening? That is, what prevents Bohnert from having structure differing from that recited in the claim? It follows that the recited method is not "necessarily present" in Bohnert. *In re Robertson*, supra.

For further example, for reasons previously discussed, Bohnert also does not teach that the alleged overlying member (54) is disposed in proximity to an exterior wall so that a receipt extending therebetween *cannot* be manually grasped with fingers prior to moving the receipt by engagement with a (single) finger through the aperture. Conversely, as previously discussed (e.g., claim 1 remarks), Bohnert's large gap (due to the angled member) permits a receipt to be manually grasped. Nor does Bohnert teach manually grasping the receipt *subsequent* to moving the receipt by movement of a finger (step b).

As previously discussed (e.g., claim 1 remarks), Bohnert teaches away from the recited method. Bohnert's use of an angled member points to (at best) his receipt being sandwiched between fingers, not between a (single) finger and an exterior wall. With Bohnert's angled member the receipt *can* be manually grasped with fingers prior to moving the receipt. Bohnert does not teach moving the receipt in the order recited. It follows that Bohnert does not explicitly or inherently teach the recited method.

Again, the Office's allegation of anticipation is based on pure speculation. The record lacks substantial evidence support. *In re Zurko*, supra. *In re Lee*, supra. Bohnert does not anticipate claim 18.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The 35 U.S.C. § 103(a) Rejections are legally improper

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

The only suggestion for the recited features and relationships is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Claims Are Not Obvious Over
Bohnert in view of Caldwell**

In the Action claims 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohnert in view of Caldwell.

Claim 10

The Action (on page 5) admits that Bohnert does not teach or suggest "depositing an article in the machine and inputting an article identifying number through an input device, and printing on the receipt the article identifying number." Caldwell does not teach or suggest the features that are admitted to be absent from Bohnert. Nor would it have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

The Action is conveniently silent as to which of Caldwell's numbered elements allegedly constitutes the recited features. Where does Caldwell teach or suggest inputting an article *identifying* number through an input device and printing the article identifying number on a receipt in the manner recited? The relied upon section of Caldwell at col. 1, line 43 to col. 2, line 17 does not teach the recited features.

In Caldwell a customer chooses a "commercial deposit" transaction, then enters an appropriate amount on the keyboard and signals "ready" by using a function key as shown in the block (132) (col. 5, lines 60-66; Figure 7A). There is no teaching or suggestion in Caldwell of entering an "article *identifying* number". Nor is there any teaching or suggestion that a receipt includes the entered article identifying number.

Thus, the Office has not established a *prima facie* showing of obviousness. The Action is devoid of any such teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. The prior art does not teach or suggest the desirability of the combination. Even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have resulted in the claimed invention. The references,

taken alone or in combination, do not teach or suggest the recited features and relationships. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 11

The Action (on page 5) admits that Bohnert does not teach or suggest "depositing an article in the machine". Appellants respectfully submit that Bohnert also does not teach inputting an amount associated with the article, and printing the amount on the receipt.

In Caldwell a customer chooses a "commercial deposit" transaction, then enters an appropriate amount on the keyboard and signals "ready" by using a function key as shown in the block (132) (col. 5, lines 60-66; Figure 7A). The ATM records the appropriate data relating to the transaction in block (144) (col. 6, lines 17-18; Figure 7B). There is no explicit or inherent teaching or suggestion in Caldwell that a receipt includes the entered amount. Caldwell appears more concerned with the receipt providing a dated record as evidence that the customer attempted a deposit at a certain time.

The Action's assertions are not based on any evidence in the record. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest the recited features and relationships. It would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention.

Claim 12

The Action (on page 5, last paragraph) admits that Bohnert does not teach or suggest "opening a depository door to a depository and placing a deposit article in the opening". That is, the Action admits that Bohnert's gasoline station does not have a *depository* (nor a depository door).

Caldwell does not teach or suggest equipping a gasoline station with a depository having a door. The prior art does not teach or suggest the desirability of the combination. The Action is devoid of any such teaching, suggestion, or motivation for modifying Bohnert to include a depository having a door. Nor has the Action explained how Bohnert's fuel island could be structurally modified to include such a depository (especially in light of the Action's admission that Bohnert lacks a depository). It would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the claimed invention.

Claim 13


Claim 13 depends from claim 12. The Action (on page 5, last paragraph) admits that Bohnert does not teach or suggest that a "depository door is unlocked responsive to both input of a card to a card reader in operative connection with the depository door and placing a key in a key actuator in operative connection with the depository door". Appellants respectfully submit that neither of the applied references, taken alone or in combination, discloses or suggests unlocking a depository door responsive to *both* the input of a card and a key.

The Action relies on Caldwell at col. 3, line 25 to col. 6, line 2 (which is almost the entire Specification). Regardless, Caldwell at col. 3, lines 57-64 states that the depository door (22) is controlled by the ATM or *alternatively* by a key lock. It follows that Caldwell's depository door (22) is not unlocked responsive to *both* the input of a card and a key. The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the claimed invention.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)

CLAIMS APPENDIX

1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
2. The method according to claim 1 wherein the overlying member includes an edge, and wherein the aperture extends into the overlying member from the edge, and wherein in step (d) the receipt is moved by a finger moving from inside the aperture to outside the aperture with the receipt in sandwiched engagement between the finger and the exterior wall.

3. The method according to claim 2 wherein the edge of the member is a downward facing edge, and wherein in step (d) the receipt is moved with a finger moving in generally a downward direction.
4. The method according to claim 1 wherein the receipt is printed on paper supplied from a roll and prior to step (d), further comprising the step of, cutting the paper with a cutter to separate the receipt from the roll.
5. The method according to claim 4 wherein the overlying member terminates in an edge, and wherein the cutting step is executed when the receipt extends below the aperture but not substantially below the edge.
6. The method according to claim 1 wherein the exterior wall includes an opening, and wherein in step (c) the receipt extends through the opening, and wherein the overlying member extends from generally above the opening to an edge positioned below the opening, wherein the aperture extends below the opening, and wherein in step (d) the receipt is moved downward by movement of the finger in the aperture.

7. The method according to claim 1 wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually grasped with fingers prior to moving the receipt by engagement with a finger through the aperture, and thereafter further comprising manually grasping the receipt.
8. The method according to claim 6 wherein the aperture extends in the overlying member from the edge, is generally centered relative to the receipt, and is sized for accepting a thumb therein, wherein in step (d) the receipt is moved by downward movement of the thumb.
9. The method according to claim 1 and further comprising the step of:

cutting the receipt with a cutter, wherein movement of the receipt in step (d) is operative to cut the receipt.
10. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting an article identifying number through an input device, and wherein in step (b) the indicia printed on the receipt includes the article identifying number.

11. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting through an input device at least one amount associated with the article, and wherein in step (b) the indicia printed on the receipt includes the amount.
12. The method according to claim 1 wherein in step (a) conducting the transaction includes opening a depository door to a depository and placing a deposit article in the opening.
13. The method according to claim 12 wherein in conducting the transaction in step (a) the depository door is unlocked prior to opening, and wherein the depository door is unlocked responsive to both input of a card to a card reader in operative connection with the depository door and placing a key in a key actuator in operative connection with the depository door.
14. The method according to claim 1 and prior to step (a) further comprising the step of fitting a panel on an exterior surface of an existing deposit accepting machine, wherein the printer is housed in the panel.
15. The method according to claim 14 wherein the panel on the exterior surface of the existing deposit accepting machine includes at least one input device, and wherein the transaction conducting in step (a) includes inputting at least one value through the input device, and wherein the indicia printed in step (b) includes the input value.

16. A method comprising the steps of:

- (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and
- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.

17. The method according to claim 16 wherein the overlying member includes a generally downward facing edge, wherein an opening is formed between the edge and the exterior wall, and wherein in step (b) the receipt is removed in a generally downward direction through the opening.

18. A method comprising:

- (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;
- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;
- (c) subsequent to (b), manually grasping the receipt.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

Attached is a copy of the Board decision (dated June 22, 2004) regarding Appeal No. 2003-0098, as identified in section (ii) of this Appeal Brief.



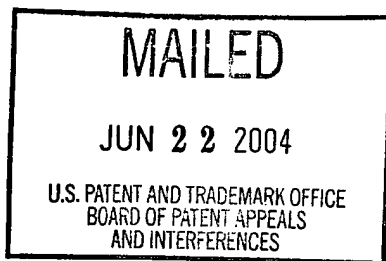
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ALAN J. ROZLOSNIK, STEVEN R. DAVIS
and MARK A. DEPIETRO



Appeal No. 2003-0098
Application No. 09/398,182

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 18,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to banking machines (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. The independent claims on appeal read as follows:

1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
16. A method comprising the steps of:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
18. A method comprising:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending

therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;
(c) subsequent to (b), manually grasping the receipt.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Caldwell	4,754,126	June 28, 1988
Imai et al. (Imai)	5,898,155	Apr. 27, 1999
McCall	6,112,981	Sept. 5, 2000

Claims 1 to 3, 5 to 8 and 10 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall and Imai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed June 3, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed April 8, 2002) and reply brief (Paper No. 11, filed June 26, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this case, the applied evidence (i.e., Caldwell, McCall and Imai) would **not** have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention for the reasons set forth in the brief and

reply brief. Method steps (c) and (d) of claim 1, method steps (a) and (b) of claim 16 and method steps (a), (b) and (c) of claim 18 are not taught or suggested by any of the applied prior art references. In that regard, we view the examiner's position that McCall's fuel dispenser 12 has a receipt dispenser, as indicated on page 9 of the answer, to be sheer speculation unsupported by the actual disclosure of McCall.¹

Since the claimed subject matter is not suggested by the applied prior art references for the reasons set forth above, we have no choice but to reverse the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 103.

¹ While we agree with the examiner that receipt dispensers are known to exist on fuel dispensers at gas stations, none of the applied prior art references actually teach or suggest such a receipt dispenser. Instead of relying on McCall, the examiner should have cited and applied a prior art receipt dispenser (see In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)) if the receipt dispenser extended a printed receipt intermediate of an exterior wall of the fuel dispenser and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member. In addition, it is not clear to us if the claimed "deposit accepting machine" is readable on a fuel dispenser that accepts debit and credit cards since the United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 18 under
35 U.S.C. § 103 is reversed.

REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2003-0098
Application No. 09/398,182

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